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In re Application of
Aarnio, Michael J., et al.
Serial No.: 10/733,556
Filed: Dec. 11, 2003
Docket: EH-10966 (03-436)
Title: DETONATIVE CLEANING APPARATUS

DECISION ON PETITION
TO WITHDRAW FINALITY
OF REJECTION UNDER
37 CFR 1.181

This is a decision on the petition filed on Aug. 20, 2007 by which petitioner requests withdrawal of the finality of the Office Action dated Jul. 18, 2007. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted in part.

A review of the relevant prosecution history shows that the applicant filed the original claims on Dec. 11, 2003. On Feb. 12, 2007, the examiner rejected claims 1-4, and 6 under 35 U.S.C. 102 and claims 5, 8 and 9 under 35 U.S.C. 103 as unpatentable over the U.S. Pat. to Hunter. In response to the non-final Office action, on May 14, 2007 the applicant filed an amendment to claims 1, 2, 3, 5 and added new claims 10-12. In particular, the applicant cancelled the dependent claim 4 and essentially combined its limitations with the original claim 1. On Jul. 18, 2007, the examiner issued a final Office action and rejected claims 1-3, 5, 6, 10 and 11 under 35 U.S.C. 103 as unpatentable over Hunter (US Pat. 5,494,004) in view of DeMart (U.S. Pat. 2,668,978)¹. In view of the totality of the paragraph 2 of page 4 of the final Office action, the examiner also appeared to separately reject claims 8, 9 and 12 under 35 U.S.C. 103 as unpatentable over Hunter in view of DeMart (U.S. Pat. 2,668,978). On Aug. 20, 2007, the applicant filed the current petition requesting withdrawal of the finality of the previous Office action. The petitioner is of the opinion that the final Office Action is incomplete because it is incongruous that, although independent claim 1 is rejected as unpatentable over Hunter, Jr. in view of DeMart, its dependent claims are not rejected in a consistent fashion. For example, dependent claims 8, 9, and 12 were rejected based solely upon Hunter, Jr. Therefore, petitioner now requests a clearer action. Petitioner also requests withdrawal of the finality of the last Office action because a new ground of rejection has been applied which was not previously applied to claim 4.

¹ Newly cited references added in the Final rejection of claims 1-3, 5, 6, 10 and 11.

Analysis of Application Record

Petitioner requests withdrawal of finality of the Office action mailed Jul. 18, 2007. The issue in the current petition is whether rewritten, independent claim 1 changed the scope of original dependent claim 4 in combination with original claim 1. If so, the new ground of rejection in the final Office action was necessitated by applicant's amendment.

In order to determine whether or not the original dependent claim 4 and the rewritten, amended independent claim 1 are identical in scope, a comparison of the claims must be made. Original independent claim 1 and original dependent claim 4 filed on Dec. 11, 2003 are reproduced below:

1. An apparatus for cleaning a surface within a vessel, the apparatus supported at least partially above a support surface and comprising: an elongate combustion conduit extending from an upstream end to a downstream end associated with an aperture in a wall of the vessel and positioned to direct a shock wave toward said surface; a guide member on the support surface; and a plurality of support assemblies supporting the combustion conduit at a plurality of locations along a length of the combustion conduit and engaging the at least one guide member.
4. The apparatus of claim 3 wherein: each support assembly comprises a trolley having first and second of the at least one pair of said at least one wheel.

The newly amended independent claim 1 as filed on May 14, 2007 is also reproduced below:

1. (Currently amended) An apparatus for cleaning a surface within a vessel, the apparatus supported at least partially above a support surface and comprising: an elongate combustion conduit extending from an upstream end to a downstream end associated with an aperture in a wall of the vessel and positioned to direct a shock wave toward said surface; a guide member on the support surface; and a plurality of support assemblies supporting the combustion conduit at a plurality of locations along a length of the combustion conduit and engaging the at least one guide member, each support assembly comprising a trolley having first and second pairs of wheels.

4. (Canceled).

It should be noted that original dependent claim 4 depended upon claims 3, 2 and 1. A comparison of the new independent claim 1 and the original dependent claim 4 reveals that the new independent claim 1 contains no limitations from the original dependent claims 2 and 3. Petitioner has incorrectly stated that the amendment filed on May 14, 2007 incorporated dependent claim 4 into claim 1. The newly amended independent claim 1 indeed changes the scope of the original dependent claim 4 because the limitations in original dependent claims 2 and 3 are omitted. In view of the newly added limitations in claim 1, the examiner needed to search and found U.S. patent to DeMart (US Pat. 2,668,97) for the rejection of amended claims 1-3, 5, 6, 10 and 11. These added limitations to claim 1 in the amendment filed on May 14, 2007 necessitated the new grounds of rejection in accordance with M.P.E.P. 706.07(a)² mailed on Jul. 18, 2007.

² MPEP 706.07(a) states in relevant part: "Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).*" (Emphasis added).

With regard to the rejection as stated in paragraph 2 of the final Office action, there appears to be a typographical error on line 2 of paragraph 2 of the final Office action. The phrase "in view of DeMart 2,669,978" was missing after the patentee "Hunter". This typographical error is regretted. The examiner is now directed to send a supplemental final Office action to correct such error. The requested relief as to a clearer Office action is granted.

Conclusion

Based on the analysis of the record, the examiner was correct in finding that the amended independent claim 1 differs in scope from original dependent claim 4. Accordingly, the change in scope of newly amended claim 1 was necessitated by applicant's amendment of May 14, 2007 and resulted in the new ground of rejection in the final Office action of Jul. 18, 2007. The requested relief to withdraw the finality of Office action of Jul. 18, 2007 cannot be granted. The requested relief as to a clearer Office action is granted.

The application was forwarded to Examiner Ndubizu via Supervisory Patent Examiner of Art Unit 3749 for preparation of a supplemental Office action which was mailed on Aug. 3, 2007. Petitioner may file a request for reconsideration of this decision, without fee. However, such a request must be filed within two months of the date of this decision. See 37 CFR 1.181. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED IN PART.

for Karen M. Young
Frederick R. Schmidt, Director
Technology Center 3700